REMARKS

Status of the Claims

In the Office Action, dated July 13, 2005, the Examiner had indicated that Claims 1-6, 8-25, and 27-32 were allowed. The Examiner had objected to Claims 36-38 as being dependent upon a rejected base claim, but had noted that these claims would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. However, the Examiner confirmed to applicants' attorney by telephone on February 03, 2006 that a new search was carried out, and based on the newly cited art, the allowance of the claims was being withdrawn. Thus, Claims 1-6, 8-25, and 27-34 remain pending in the application, Claims 7, 26, 35, 36, 37 and 38 having been previously canceled and Claims 11 and 19 having been amended to recite "contacts" instead of "contracts."

Claims Rejected under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 1-6, 8-25, and 27-34 under 35 U.S.C. § 103(a) as being unpatentable over Kaji et al. (U.S. Patent No. 6,183,367, hereinafter referred to as "Kaji") in view of Appelman et al. (U.S. Patent No. 6,677,968, hereinafter referred to as "Appelman"), and further in view of Das et al. (ACM Publication VRST' 97 "NetEffect: A Network Architecture for Largescale Multi-user Virtual Worlds," hereinafter referred to as "Das").

Claims 2, 4, 8, 10-11, 13, 15-16, 21, 24-25, 27-28, 30, 32, 34-35 are rejected over the art as applied as above in rejecting Claims 1, 14, 29, and 33. Furthermore, the Examiner asserts that Kaji and Appelman teach and describe a system and method of computer games that is played over the computer network. However, note that Claim 35 was previously cancelled and that its rejection is therefore moot.

Claims 3, 5-7, 9, 12, 17-19, 22, 26, 31 and 36 are rejected over the art as applied above in rejecting Claims 2, 4, 8, 11, 16, 21, 25, 30, and 35. Furthermore, the Examiner asserts that Kaji and Appelman describe a system and method of on-line messaging that facilitates users selecting participants. However, applicants note that Claim 35 and 36 were previously cancelled, so their rejection is moot.

Claims 20 and 23 are rejected over the art as applied above in rejecting Claims 19 and 22. Furthermore, the Examiner asserts that Kaji and Appelman teach and describe an on-line game playing mechanism.

Applicants respectfully disagree with the preceding rejections for the reasons set forth below.

In the interest of reducing the complexity of the issues for the Examiner to consider in this response, the following discussion focuses on independent Claims 1, 14, 29, and 33. The

1   patentability of each remaining dependent claim is not necessarily separately addressed in detail.

2   However, applicants' decision not to discuss the differences between the cited art and each dependent

3   claim should not be considered as an admission that applicants concur with the Examiner's conclusion

4   that these dependent claims are not patentable over the disclosure in the cited references. Similarly,

5   applicants' decision not to discuss differences between the prior art and every claim element, or every

6   comment made by the Examiner, should not be considered as an admission that applicants concur with

7   the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of

8   the dependent claims patentably distinguish over the references cited. Moreover, a specific traverse of the

9   rejection of each dependent claim is not required, since dependent claims are patentable for at least the

10 same reasons as the independent claims from which the dependent claims ultimately depend.

11 <u>Discussion of the Patentability of Independent Claim 1</u>

12 Significant differences exist between applicants' claim recitation and the cited art because the

13 cited art does not teach or suggest a host player. Steps (a), (b), (c), and (e) of applicants' independent

14 Claim 1 recite a *host player*, as emphasized by the use of italic font for the term, as set forth below.

15   (a)   enabling the *host player* to create a list of contacts comprising
16 one or more other persons who may be interested in participating in playing the
    multiplayer online electronic game;

17   (b)   enabling the *host player* to select one or more of the other
18 persons from among the list of contacts to participate in playing the multiplayer online
    electronic game;

19   (c)   automatically sending an electronic invitation to each of the one
20 or more other persons selected by the *host player*, to join in playing the multiplayer
    online electronic game;

21   (d)   enabling each of the one or more other persons who receive the
22 electronic invitation that was automatically sent, to selectively join the multiplayer
    online electronic game as a participant; and

23   (e)   providing an availability status for each person in the list of
24 contacts so as to enable the *host player* to identify persons in the list of contacts who
    are currently available for playing the multiplayer online electronic game.

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26 With respect to independent Claim 1, the Examiner asserts that Kaji discloses the equivalent of

27 applicants' step (a) – (d) and in support of his assertion, cites Figure 9, and column 8, line 55 through

28 column 9, line 41, which is reproduced below:

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The communicative game system 1 illustrated in FIG. 9 involves four game devices 2a-2d connected by cables in a ring configuration, and it conducts communications on the basis of the aforementioned broadcast communications method and simultaneous communications method. The game devices 2a-2d respectively comprise a communications system 31. *host system 32*, video camera 33, monitor 34, microphone 35, and speaker 36, as shown in the diagram. The communications system 31 has a similar composition and functions to the aforementioned communications system. (Emphasis added, Kaji, column 8, lines 55-65.)

Each **host system 32** is a system whereby the respective <u>players</u> execute the game, and it comprises a CPU board 32a, video board 32b and ROM board 32c (see FIG. 10). Each communications system 31 is formed onto a communications board and is connected to a **host system 32** via a connector. The communications board 31 is connected to a video camera 33, monitor 34, microphone 35 and speaker 36. FIG. 10 shows the state of connections between boards of a communications system 31 and **host system 32**. In this drawing, the communications board 31 and the CPU board 32a of the **host system 32** are connected by means of a connector CP1. Furthermore, the CPU board 32a in the **host system 32** and the ROM board 33c, and the CPU board 32a and the video board 32b, are connected respectively by means of connectors CP2, CP3. RGB data (game data), sound signals and a synchronizing signal are transferred from the video board 32b to the communications board 31 by means of a signal cable. The video camera 33 is constituted by a CCD camera, for example. The video camera 33 is positioned such that it can capture a portion of the <u>player</u>, for example, his or her face (see FIG. 12), and the image of the <u>player's</u> face taken by this camera is transmitted to the other game devices. (Emphasis added, Kaji, column 8, line 66-column 9, line 21.)

The monitor 34 is constituted by a CRT display, for example. In the communications board 31, the RGB data and the synchronizing signal from the video board 32b are synthesized with (superimposed on) data transmitted from the other game devices and sent to the relevant monitor 34, where it is displayed. FIG. 11 shows a screen example of a monitor 34 displaying an image processed in this way. The transmitted image is, for example, displayed in a window on the monitor screen, as shown in this diagram. This window screen may display, for example, the facial expression of the *player* operating the leading car in a racing game. Furthermore, in a car racing game, it may display the facial expression of a friendly *player* who is on the same team. (Kaji, column 9, lines 22-34.)

The microphone 35 is located in a prescribed position on the casing of each game device, such that it can detect the voice of the *player* (see FIG. 12). The sound signal from the microphone 35 is transmitted to the other game devices via the communications board 31, and it is output from the speaker 36 along with the sounds of the game, and thereby transmitted to the other *players*. (Kaji, column 9, lines 35-41.)

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However, as noted in the bold font portion in the Examiner's citation above, Kaji teaches a **host system** as opposed to a **host** *player*. As noted above in the underlined portion, Kaji teaches that players execute the game, that the video camera is positioned such that it can capture a portion of the player, such as an image of the player's face, including facial expressions, and that a player's voice and the game sounds are transmitted to the other players. But does not Kaji teach or suggest any equivalent of applicants' step (a), which recites that a *host player* is enabled to create a list of contacts; nor any equivalent of applicants' step (b), which recites that the *host player* is enabled to select one or more of the other persons from among the list of contacts; nor any equivalent of applicants' step (c), which recites that an electronic invitation is sent to each of the one or more other persons selected by the *host player*, nor any equivalent of applicants' step (e), which recites that an availability status is provided for each person in the list of contacts so as to enable the *host player* to identify persons in the list of contacts. Thus, Kaji fails to teach or suggest applicants' claim recitation regarding the functionality of a host player.

Furthermore, the Examiner admits that Kaji does not explicitly disclose creating a list of contacts to initiate a chat, in order to join a player playing a multiplayer online game. The Examiner relies upon Appelman as teaching a computing environment and teaching methods and apparatus for tracking users' (i.e., players') availability, relationships, and maintaining knowledge of the players on a system with a unique way of establishing and maintaining user definable on-line co-user (i.e., invited player) lists, corresponding to creating a list of contacts comprising one or more other persons who may be interested in participating in playing the multiplayer online electronic game. In support of his assertion, the Examiner cites FIGURE 6 and 10 and column 5, line 14-column 7, line 6.

Therefore the Examiner concludes that it would have been obvious to one of ordinary skill in the art to combine the teachings of Kaji and Appelman, because Appelman's method of producing a definable online player list for interpersonal communication on a gaming network would not only promote a flexible structure in the system of Kaji during playing of multiplayer online computer games and receiving data from host player and other invited players, but would also provide an online messaging interface (such as for chat participants) to facilitate enabling individuals to host and invite other players to join the game from a defined chat list and giving ability to the invited player to accept or decline the invitation. In support of his conclusion, the Examiner cites column 2, line 3 to line 17 of Appelman. Applicants respectfully disagree with this conclusion for the following reasons.

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First, as described above, Kaji does NOT teach or suggest a host player. Second, it would NOT have been obvious to one of ordinary skill in the art to combine Kaji and Appelman as proposed by the Examiner, because Appelman does not teach or suggest a gaming network and is therefore not analogous art in regard to applicants' claims. The Abstract of Appelman states:

> A real time notification system that tracks, for each user, the logon status of selected co-users of an on-line or network system and displays that information in real time to the tracking user in a unique graphical interface. The invention provides user definable on-line co-user lists, or "buddy lists", that track specific co-users in real-time automatically. A user can create many separate buddy lists of co-users, either with intersecting or disjoint lists of users, and label these buddy lists according to the user's preference. The user can update a buddy list or create new buddy lists whenever necessary. When a user logs on to a system, the user's set of buddy lists is presented to the buddy list system. The buddy list system attempts to match co-users currently logged into the system with the entries on the user's buddy list. Any matches are displayed to the user. As co-users logon and logoff, a user's buddy list is updated to reflect these changes. An indication can also be added to show that a co-user just logged on or just left the system. (Appelman, Abstract.)

Thus, Appelman is a notification system for each user who is logged onto a system. Appelman does not teach or suggest any kind of gaming system. The citation to column 5 of Appelman teaches that FIGURE 6 is a graphical display of one implementation of the invention, showing a Buddy List Preferences, FIGURE 7 is a graphical display showing a Search Member Directory, FIGURE 9 is a graphical display showing an Instant Message window, and FIGURE 10 is an implementation showing a Buddy Chat window. Contrary to what the Examiner asserts, there is no mention in the reference that Appelman might be utilized for a gaming network. Accordingly, there is no motivation that would lead one of ordinary skill in the art of gaming to refer to Appelman or to combine Appelman with Kaji. And, even if the motivation did exist, as described above, Kaji does not teach a host player, so that the combination fails to provide an equivalent of what applicants have claimed.

Thus, Claim 1 distinguishes over Kaji in view of Appelman. Accordingly, the rejection of independent Claim 1 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further in view of Das should be withdrawn. Because dependent claims inherently include all of the recitation of the independent claims from which the dependent claims ultimately depend, and because the combined cited references do disclose or suggest all of the elements of independent Claim 1, the rejection of dependent Claims 2-6 and 8-13 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further in view of Das should be withdrawn for at least the same reasons as the rejection of Claim 1.

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Discussion of the Patentability of Independent Claim 14

Independent Claim 14 is directed towards a method for enabling a host player to select one or more other players to participate in a multiplayer online electronic game played using a plurality of electronic devices linked in communication over a communications network, each of said plurality of electronic devices being operated by a different player. The Examiner has rejected this claim for reasons similar to Claim 1, but in addition to the citations applied to Claim 1, cites column 10, line 20 to column 11, line 30 of Kaji.

Note that Claim 14 also recites the term "host player" in steps (a), (b), and (d). The additional citation to column 10 does not correct the problem that this reference fails to teach or suggest a "host player" as applicants' claim recites. Instead, Kaji only teaches a host system. Thus, Claim 14 distinguishes over Kaji in view of Appelman, because Kaji (and Appelman and Das) does not teach or suggest a host player. Accordingly, the rejection of independent Claim 14 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further in view of Das should be withdrawn. Because dependent claims inherently include all of the recitation of the independent claims from which the dependent claims ultimately depend, and because Kaji, in view of Appelman, and further in view of Das does not disclose or suggest all of the elements of independent Claim 14, the rejection of dependent Claims 15-25 and 27-28 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further in view of Das should be withdrawn for at least the same reasons as the rejection of Claim 14.

Discussion of the Patentability of Independent Claim 29

Independent Claim 29 is directed towards a method for enabling a host player to select one or more other players to participate in a multiplayer online electronic game played using a plurality of electronic devices linked in communication over a communications network. The Examiner has rejected this claim for reasons similar to Claim 1 and in addition to the citations applied in the rejection for Claim 1, cites column 10, line 20 to column 11, line 30.

Note that Claim 29 also recites the term "host player" in steps (a), (b), (d), and (e). As was the case in regard to the citation applied against independent Claim 1, the added citation to column 10 does not teach or suggest a host player, but only teaches a host system. Thus, Claim 29 distinguishes over Kaji, in view of Appelman, and further in view of Das. Accordingly, the rejection of independent Claim 29 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further in view of Das should be withdrawn. Because dependent claims inherently include all of the recitation of the independent claims

from which the dependent claims ultimately depend, and because Kaji, in view of Appelman, and further in view of Das does not disclose or suggest all of the recitation of independent Claim 29, the rejection of dependent Claims 30-32 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further in view of Das should be withdrawn, for at least the same reasons as the rejection of Claim 29.

Discussion of the Patentability of Independent Claim 33

Independent Claim 33 is directed towards a system for enabling a host player to select one or more other players to participate in playing a multiplayer online electronic game played using a plurality of electronic devices linked in communication over a communications network. The Examiner has rejected this claim for reasons similar to Claim 1 and in addition to the citations provided to support the rejection of Claim 1 and of the other independent Claims, cites column 22, line 25 to line 63 of Kaji, which is reproduced below:

> FIGS. 57 and 55 illustrate cases where sound effects are processed by hardware circuits. (Kaji, column 22, line 25-line 26.)

> The circuit shown in FIG. 57 relates to a composition for synthesizing noise and sound effects with the voice of the (home) player and then transmitting it to other machines. The analogue voice signal detected by the microphone is amplified by passing it through a microphone amplifier, and it is then converted to a digital signal by an A/D converter and sent to a synthesizer. The digital signal output from the A/D converter is detected by a detecting circuit, and this detection information is passed to the CPU. The CPU drives a noise generator and effects generator in response to the voice being detected, and noise sound data and effects sound data are supplied respectively to the synthesizer. The synthesizer then synthesizes the sound data, noise data and effects data, and transmits them to the communications module. Thereby, data relating to the player's voice is carried in the communications data output from the communications module. (Kaji, column 22, line 27-line 43.)
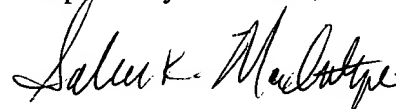
> The circuit shown in FIG. 58 relates to a composition whereby noises and effects are synthesized with the received voice signal of a player (opponent) at another game device. The reception data in the communications module (reception module) is supplied to a synthesizer (first synthesizer), and it is also supplied to a command decoder. The command decoder decodes the sound data in the reception data and transmits the results to the CPU. In response to this, the CPU controls a noise generator, causing it to output noise data to the synthesizer, and it also controls around effects generator, causing it to output sound effects data to the synthesizer. Accordingly, the synthesizer then synthesizes the voice data, noise data and effects data, and transmits the synthesized signal to a second synthesizer via a D/A converter. The second synthesizer is also supplied with a sound signal (analogue) corresponding to the state of development of the game from the game circuit board (**host system**) of

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the home device. Therefore, the two sound signals are synthesized at the second synthesizer and output to a speaker. (Emphasis added, Kaji, column 22, line 44-.)

Note that Claim 33 also recites a host player in subparagraph (e)(i), (ii), (iv), (vi), and (vii). Similar to the Examiner's citation for independent Claim 1 and the Examiner's citation to column 10 for independent Claims 14 and 29 reproduced above, the citation to column 22 does not teach or suggest a host player as applicants recite, but only teaches a host system. Thus, Claim 33 distinguishes over Kaji in view of Appelman. Accordingly, the rejection of independent Claim 33 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further in view of Das should be withdrawn. Because dependent claims inherently include all of the elements of the independent claims from which the dependent claims ultimately depend. Because Kaji, in view of Appelman, and further in view of Das does not disclose or suggest all of the recitation of independent Claim 33, the rejection of dependent Claim 34 under 35 U.S.C. § 103(a) over this combination of references should be withdrawn for at least the same reasons as the rejection of Claim 33.

In view of the Remarks set forth above, it will be apparent that the claims remaining in this application define a novel and non-obvious invention, and that the application is in condition for allowance and should be passed to issue without further delay. Should any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,

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MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, on February 9, 2006.

Date: February 9, 2006

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